

REMARKS

Restriction Requirement

The Office has set forth a restriction requirement. In particular, the Office requires Applicant to elect one of the following groups:

- (I) claims 1-32 and 52, drawn to a pigmented cosmetic composition (class 424, subclass 401),
- (II) claims 33-38, drawn to a method of inhibiting separation of a pigmented cosmetic composition (class 424, subclass 401), and
- (III) claims 39-51, drawn to a method of preparing a pigmented cosmetic composition (class 424, subclass 401).

Election in Response to Restriction Requirement

Applicant hereby elects, with traverse, the claims of Group I (i.e., claims 1-32 and 52).

In regard to the election, Applicant respectfully submits that the claims of Groups II and III (i.e., claims 33-51) should be examined with the claims of Group I for the reasons set forth below.

Discussion of the Restriction Requirement

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*” (M.P.E.P. § 803, emphasis added).

In the case at hand, the Office fails to meet the above-identified criteria and to present the required supporting evidence and reasoning. There is significant overlap in subject matter between Groups I-III, such that references considered during the examination of the claims of one group would be considered during the examination of the claims of the other group. For example, a search of the prior art for references relevant to a pigmented cosmetic composition comprising a water-in-oil emulsion comprising (a) an oil phase; (b) an aqueous phase; (c) a pigment; (d) an emulsifier; and (e) a separation inhibitor comprising a silicone elastomer most likely would be relevant to Groups I, II, and III. For example, claim 33, part of Group II, recites a method of inhibiting separation of a pigmented cosmetic composition

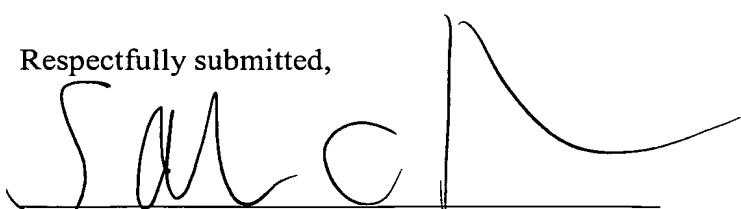
comprising a water-in-oil emulsion comprising (a) an oil phase; (b) an aqueous phase; (c) a pigment; (d) an emulsifier, and/or sunscreening particulate, said method comprising including component (e) a separation inhibitor comprising a silicone elastomer in the emulsion. Similarly, claim 39, part of Group III, recites a method of preparing a pigmented cosmetic composition comprising preparing a first water-in-oil emulsion comprising (a) an oil phase; (b) an aqueous phase; (c) a pigment; (d) an emulsifier, and/or sunscreening particulate, and (e) a separation inhibitor comprising a silicone elastomer; preparing a second water-in-oil emulsion comprising (a) a second oil phase; (b) a second aqueous phase; (c) a second pigment, (d) a second emulsifier and/or sunscreen particulate component; and mixing said first water-in-oil emulsion with said second water-in-oil emulsion to form the composition. Therefore, the methods of Groups II and III are directly related to the composition recited in Group I. In this regard, Applicant points out that the claims of Groups (I), (II), and (III) are classified in the same class and subclass. This is not to say that the claims stand or fall together. Rather, the overlap in the relevance of subject matter, potential references, and the classification of the claimed subject matter suggests that there is no need for a restriction requirement.

Thus, the Office has failed to meet the criteria for a proper requirement for restriction. Applicant respectfully submits that the requirement for restriction is improper and should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Salim A. Hasan, Reg. No. 38,175
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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